

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed September 23, 2008 and Advisory Action dated January 13, 2009. At the time of the Final Office Action, Claims 1-15 were pending in this Application. Claims 1-15 were rejected. Claim 1 has been amended. Claims 6 and 7 were previously cancelled without prejudice or disclaimer and Claims 16-21 were previously withdrawn due to an election/restriction requirement. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1-2, 4-5 and 8-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over German Patent No. 19715487 by Johannes Fitzner et al. (“*Fitzner*”) and further in view of International Application Publication No. WO2004/004021 by Markus Mohr (“*Mohr*”).

Claim 3 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Fitzner* in view of *Mohr* and in view of U.S. Patent No. 4,778,358 issued to Werner Pape (“*Pape*”).

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination

was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Applicants submit that *Mohr* and *Fitzner*, alone or in combination, fail to teach the elements of amended Claim 1, which recites:

1. A piezo actuator for actuating an injector for an injection system of an internal combustion engine, comprising a cage-shaped holder for spatially fixing a piezo stack and two associated connection pins for electrical contacting of the piezo stack, wherein the cage-shaped holder comprises a top plate, a bottom plate, and a first rib and a second rib, wherein the first and second rib physically support and couple said top and bottom plate to pre-form said cage-shaped holder, the top plate and the bottom plate each comprise cutouts to receive a single piezo stack inserted into the pre-formed cage-shaped holder.

Mohr and *Fitzner* fail to teach a “cage-shaped holder [that] comprises a top plate, a bottom plate, and a first rib and a second rib, wherein the first and second rib physically support and couple said top and bottom plate to pre-form said cage-shaped holder.”

The Examiner acknowledges that *Fitzner* does not teach such elements. (Final Office Action, page 3).

Mohr also does not teach such elements. The Examiner alleges that element 6 of *Mohr* can be equated with the first and second ribs recited in Applicants' Claim 1. However, element 6 in *Mohr* refers to strips of insulating foil (*Mohr*, page 3, line 18 refers to “Isolierfolien 6,” which translates to “insulating foil 6”). As known in the art, such insulation foils are very thin foils attached to the sides of the piezo stack 1, and not to the top housing part 8 or bottom housing part 9. These thin insulating foils not only *do not*, but physically *cannot*, “physically support and couple [a] top and bottom plate to pre-form [a] cage-shaped holder.”

Further, *Mohr* and *Fitzner* also fail to teach “the top plate and the bottom plate each comprise cutouts to receive a single piezo stack inserted into the pre-formed cage-shaped holder.” In the technique shown in Fig. 3 of *Mohr*, insulating foils 6 are attached to opposite corners of the piezo stack 1, which is then inserted into the cutout in cylindrical part 7. The insulating foils 6 do not form a “cage-shaped holder” with housing parts 8 and 9 (or with any other parts), much less a “pre-formed cage-shaped holder” that can receive a piezo stack inserted into the pre-formed cage-shaped holder.

For at least these reasons, amended Claim 1 is allowable over the proposed combination of *Mohr* and *Fitzner*. Thus, Applicants respectfully request reconsideration and allowance of amended Claims 1, as well as Claims 2-5 and 8-15 that depend therefrom.

CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants respectfully submit a Request for Continued Examination (RCE) Transmittal and a Petition for Two Months Extension of Time. The Commissioner is authorized to charge \$810.00 (RCE) and \$490.00 (Two Month Extension of Time) to Deposit Account 50-2148 in order to effectuate this RCE filing.

Applicant believes there are no other fees due at this time. However, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2689.

Respectfully submitted,
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